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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,419	03/01/2002	Dieter Dohring	616.95USWO	2940
23552	7590	11/30/2005	EXAMINER	
MERCHANT & GOULD PC			WATKINS III, WILLIAM P	
P.O. BOX 2903			ART UNIT	PAPER NUMBER
MINNEAPOLIS, MN 55402-0903			1772	

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/980,419

Applicant(s)

DOHRING ET AL.

Examiner

William P. Watkins III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE Three MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3, 6-10, 12, 15-20 and 22-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3, 6-10, 12, 15-20 and 22-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 31-32, 33, 3, 6-10, 12, 19-20, 22-25, 34, 15, 26, 27, 16, 17, 18, 28, 29, and 30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

It is not clear where the instant specification supports the 15 to 60 grams per square meter basis weight of the paper, as now claimed, as being the weight after impregnation.

2. Applicant's arguments filed 16 September 2005 regarding the new matter rejection have been fully considered but they are not persuasive.

Applicant argues that the specification must be read as a whole in that it is desired to produce a tear resistant paper and that this implies that the paper is impregnated and that therefore all references to weight regarding the paper are to the paper and the resin and not to the paper weight alone. The

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examiner does not see how the nature of the final product can be used to draw an inference as to if paper weight includes resin or is the weight before impregnation. Applicant also argues that the German language in the priority document was not clearly translated regarding the nature of the paper weight. The examiner notes that the priority document was not incorporated by reference into the instant specification and is therefore not available to correct errors in the instant specification.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jaisle et al. (U.S. 4,473,613) in view of applicant's admission of the state of the art at page 1, lines 15-20.

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Jaisle et al. teaches the formation of a decorative laminate using an acrylic resin and a melamine resin and abrasive particles (col. 2, lines 55-65), that are pressed and impregnated into the décor sheet of a core (carrier) and décor sheet laminate by a belt press or other means (col. 7, lines 25-35, col. 5, lines 20-35). The weight of the paper in the décor sheet can be between 16 and 160 grams per square meter (col. 4, lines 35-40). Applicant admits that tiles are formed by decorative overlays on core or carrier layers and that counter pull layers are conventional to counter balance the decorative décor layer. The instant invention claims an acrylate resin impregnated into a décor layer, which is used to form a tile laminate with the impregnated paper having a weight between 15 and 60 grams per square meter. It would have been obvious to one of ordinary skill of the art to have added a counter pull layer to the core and décor layer of Jaisle et al. in order to stabilize the decorative laminate in view of applicant's admission. It further would have been obvious to select a paper weight in the lower range of the 16 to 160 gram range taught by the reference and impregnate it with up to 30 to 45 weight percent of resin based on the weight of the paper because of he teachings of the reference to impregnate with that amount of

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resin (col.4, lines 60-65, col. 4, lines 10-15). A 16 gram per square meter paper impregnated with 30 weight percent resin based on the weight of the paper would yield an impregnated paper of about 21-22 grams per square meter. This would be within applicant's argued claim limitation of 15 to 60 grams per meter of impregnated paper.

5. Claims 34, 15, 26, 27, 16, 17, 18, 28, 29, 30 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jaisle et al. (U.S. 4,473,613) in view of applicant's admission of the state of the art at page 1, lines 15-20 as applied to claims 31-32 above, further in view of Mehta (U.S. 5,213,883).

Jaisle et al. teaches the use of pigmented paper that is then impregnated with resin (col. 4, lines 35-40). Mehta teaches the use of titanium dioxide as a pigment with renders a décor paper opaque col. 1, lines 55-65). The instant invention claims a titanium dioxide pigment impregnated into a décor sheet with acrylic resin. It would have been obvious to one of ordinary skill of the art to have used titanium dioxide as the specific pigment in the paper of Jaisle et al. in order to make the paper opaque because of the teachings of Mehta.

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6. Claims 33, 3, 6, 7, 8, 9, 10, 19, 20, 22, 23, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jaisle et al. (U.S. 4,473,613) in view of applicant's admission of the state of the art at page 1, lines 15-20, further in view of Mehta (U.S. 5,213,88) as applied to claims 31-32, 34, 15, 26, 27, 16, 17, 18, 28, 29, 30 and 12 above, and further in view of Koutitonsky et al. (U.S. 5,753,078) and Scher et al. (U.S. 4,093,766).

Koutitonsky et al. teaches the impregnation of a paper with a saturant by the use of a size press that has two rollers that transfer a coating material to a paper that passes through a nip between the two rollers. The pressure of the nip and amount of coating being adjustable to allow for saturation or impregnation of the paper with the coating material. The coating material being distributed on the rollers by the use of a doctor blade (col. 1, lines 15-45). Scher et al. teaches the use of a impregnation resin to carry a pigment into a décor paper in order to allow for variation in the degree of pigment level in the paper (col. 4, lines 30-50). The instant invention claims the use of rollers to transfer a coating to a paper used as décor sheet in a tile, the resin impregnating the paper and carrying a pigment into the paper. It would have been obvious

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to one of ordinary skill in the art to have impregnated the acrylic coating of Jaisle et al. as modified above using nip coating rollers in order to provide good control of the amount of coating because of the teachings of Koutitonsky et al. It further would have been obvious to have added pigment to the resin of Jaisle et al. as modified above in order to have control of the degree of pigmentation because of the teachings of Scher et al.

7. Applicant's arguments filed 16 September 2005 have been fully considered but they are not persuasive.

Applicant argues that the declaration filed 16 September 2005 by Mr. Dohring provides evidence that the paper of Jaisle et al. is a finish foil that has gloss coatings on the outside of the paper sheet and not resin that impregnates the sheet because the reference has no teaching of the resin being forced into the paper sheet. The examiner disagrees that the declaration provides clear evidence on this issue. As a first point Jaisle et al. uses the words impregnate or impregnated repeatedly to describe the state of the resin in the paper sheet and explicitly states that the resin is impregnated using a dip and squeeze method (col. 4, lines 5-15), which implies putting

pressure on the resin to force it into the paper. The declaration fails to address these points and instead states that there is no teaching what so ever of forcing the resin into the paper. The declaration states that Exhibit A is a finish foil that is a commercial product made by the process of Jaisle et al. It is unclear how the declarant knows that this product is made by the process of Jaisle et al. other than that it is a coated finish paper. It is not stated that Exhibit A was made by the declarant using the dip and squeeze method of Jaisle et al. The dip and squeeze step of Jaisle et al. is taken by the examiner as providing some de-aeration of the paper. The claimed paper weight range that includes the resin weight is dealt with in the above rejections.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will

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expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Watkins III whose telephone number is 571-272-1503. The examiner works an increased flex time schedule, but can normally be reached Monday through Friday, 11:30 A.M. through 8:00 P.M. Eastern Time. The examiner returns all calls within one business day unless an extended absence is noted on his voice mail greeting.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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WW/ww

November 28, 2005

William P. Watkins III

**WILLIAM P. WATKINS III
PRIMARY EXAMINER**